



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/728,857	12/01/2000	Gary W. Kwong	56208USA8A	4252
32692	7590	08/10/2005	EXAMINER	
3M INNOVATIVE PROPERTIES COMPANY			JUSKA, CHERYL ANN	
PO BOX 33427			ART UNIT	PAPER NUMBER
ST. PAUL, MN 55133-3427			1771	

DATE MAILED: 08/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/728,857

Applicant(s)

KWONG ET AL.

Examiner

Cheryl Juska

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 June 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 56-66 and 68-81 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 56-66 and 68-81 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.

### ***Response to Amendment***

2. Applicant's amendment filed June 16, 2005 has been entered. Claims 56 and 69-71 are amended as requested. Claims 1-55 and 67 are cancelled. Thus, the pending claims are 56-66 and 68-81.

3. Said amendment is sufficient to withdraw the 112, 2<sup>nd</sup> rejections set forth in sections 3-6 of the last Office Action. Additionally, said amendment is sufficient to overcome the 103 rejection of claims 56-66 and 79-81 as being obvious over Sugawara (US 4,240,943) and Tetenbaum (US 4,499,233) as set forth in section 8 of the last Office Action.

### ***Claim Rejections - 35 USC § 103***

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 56-66 and 79-81 are rejected under 35 USC 103(a) as being unpatentable over US 4,240,943 issued to Sugawara and US 4,499,233 issued to Tetenbaum in view of US 5,073,442

Art Unit: 1771

issued to Knowlton, US 3,632,419 issued to Horie, and US 5,770,656 issued to Pechhold, as applied to claim 67 in section 9 of the last Office Action.

The limitations of cancelled claim 67 have been incorporated into independent claim 56. As such, claims 56-66 and 79-81 are rejected for the reasons set forth with respect to claim 67.

6. Claims 68-72, 73, and 78 stand rejected under 35 USC 103(a) as being unpatentable over US 4,240,943 issued to Sugawara and US 4,499,233 issued to Tetenbaum in view of US 5,073,442 issued to Knowlton, US 3,632,419 issued to Horie, and US 5,770,656 issued to Pechhold, as set forth in section 9 of the last Office Action.

7. Claims 74 and 75 stand rejected under 35 USC 103(a) as being unpatentable over the cited Sugawara, Tetenbaum, Knowlton, Horie, and Pechhold references in view of US 5,370,919 issued to Fieuchs et al., as set forth in section 11 of the last Office Action.

8. Claim 76 stands rejected under 35 USC 103(a) as being unpatentable over the cited Sugawara, Tetenbaum, Knowlton, Horie, and Pechhold references in view of US 3,493,424 issued to Mohrlök et al., as set forth in section 12 of the last Office Action.

9. Claim 77 stands rejected under 35 USC 103(a) as being unpatentable over the cited Sugawara, Tetenbaum, Knowlton, Horie, and Pechhold references in view of US 4,007,305 issued to Kakar et al., as set forth in section 13 of the last Office Action.

### *Response to Arguments*

10. Applicant's arguments filed with the amendment have been fully considered but they are not persuasive. Specifically, the argument regarding the utility of the long chain alcohol (i.e., capping agent versus water repellency) is unpersuasive since the claims do not limit the intended

Art Unit: 1771

use or function of said alcohol. Rather, the claim states a urethane comprising the reaction product of a long chain alcohol. Tetenbaum's teaching of a long chain alcohol as a capping agent for a urethane meets this limitation.

11. With respect to applicant's argument that the Knowlton, Horie, and Pechhold references do not teach the claimed stainblockers can be used

with a urethane composition, it is noted that the primary reference of Suguwara teaches the use of stainblockers with urethanes.

12. Applicant also argues there is no motivation to combine the references. In response, Suguwara's lack of an explicit teaching for suitable stainblockers motivates one to look to the prior art to find such. Therefore, applicant's arguments are unpersuasive and the rejections stand.

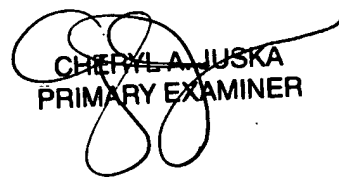
### ***Conclusion***

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl Juska whose telephone number is 571-272-1477. The examiner can normally be reached on Monday-Friday 10am-6pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached at 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

14. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

Art Unit: 1771

applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
CHERYL A. JUSKA  
PRIMARY EXAMINER

cj  
August 8, 2005